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Serial No. 09/764,558
Response to Official Action

In the Drawings

There are no amendments to the drawings.

Remarks

Applicant has amended Claim 1 and added new Claims 18-25. Applicant respectfully submits that no new matter was added by the amendment, as all of the amended matter was either previously illustrated or described in the drawings, written specification and/or claims of the present application. For example, Claims 18-20 and 25 are supported by the written specification at page 10, lines 14-17; Claims 21 and 22 are supported by the written specification at page 7, lines 10-23; and Claim 23 is supported by the written specification at page 8, lines 22-27. Entry of the amendment and favorable consideration thereof is earnestly requested.

As amended, Claim 1 requires among other limitations, an indication selected by a player from said plurality of indications, said indication submitted by the player to said computer over said computer network. Further, Claim 24 requires among other limitations, an indication selected by the player from said list of indications and submitted by the player to said computer. Applicant respectfully submits that this limitation is not taught or suggested in the cited prior art.

The '501 patent teaches an automatic matching system, not a system where the player selects an indication and submits the selection over a network as required by Claims 1 and 24. For example, the '501 patent teaches "matching the active bids and offers in the system, determines the quantity of permissible match at the lowest common counterparty credit limit and the best bid ask price for the largest available

quantity for automatically completing the potential matching transaction.” (col. 4, lines 6-11) (emphasis added). Also, the host computer “dynamically updates the prices based on the best available bids in the system, processes the matching transactions for a given instrument in time order entry to the matching system.” (col. 4, lines 11-15).

Nowhere however, does the ‘501 patent teach or suggest that a player or trader selects and indication and submits the selected indication. Rather, the ‘501 patent repeatedly emphasizes that the system is a “matching system for trading instruments . . . in which bids are automatically matched against offers for given trading instruments for automatically providing matching transactions in order to complete trades.” (col. 3, lines 18-22; *See also*, col. 7, lines 13-15, “If a match is found, and satisfies all criteria, including not exceeding the gross counterparty credit limit, then the trade is automatically executed.”).

However, the automated system taught in the ‘501 patent is undesirable because “the best bid ask price” for the indication may not be the only factor that must be considered prior to selection. A player/trader may prefer an offer that is not the lowest price, but may be preferred based on other factors, such as place of delivery. For example, a player/trader may decide to select a higher price for a particular commodity based on where that commodity is to be delivered. The time of year may also be a factor in determining delivery preferences, just to name a few factors. These dynamic decisions may be made by the player/trader who can react to market conditions, at least in part because the present system provides for “an indication selected by a player from

said plurality of indications, said indication submitted by the player to said computer over said computer network” as required by Claims 1 and 24.

It is well settled that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In the present case, Applicant respectfully submits that a primary objective of the '501 patent is to provide an automatic matching system for automatically providing matching transactions in order to complete trades. Therefore, any modification of the '501 patent according to the Claims 1 and 24 to require player selection and submission would destroy the objective of the system taught in the '501 patent.

Accordingly, because the '501 patent fails to teach or suggest, an indication selected by a player from said plurality of indications, said indication submitted by the player to said computer over said computer network as required by Claims 1 and 24, but rather teaches directly away from this limitation using an automated system, the '501 cannot render Claims 1 or 24 obvious.

As amended, Claim 1 also requires among other limitations, a database accessible by said computer containing a plurality of indications submitted by and identified with players of the system to said computer over said computer network, wherein each of said plurality of indications identified with a particular player, relates to a bid or offer for a specified number of units of a specified commodity at a specified unit

price. Further, Claim 24 requires among other limitations, an indication including a specified number of units of a specified commodity at a specified unit price by a particular identified player. Applicant respectfully submits that this limitation is not taught or suggested in the cited prior art.

The '501 patent teaches "a host computer means (20) comprising means for anonymously matching active bids and offers in the system by trading instrument based on a variable matching criteria." (Abstract) (emphasis added). In fact, the title of the invention is "Anonymous Matching System." (Title of the Invention, emphasis added; *See also*, col. 3, lines 39-41; col. 4, lines 6-11 & 37-39; col. 6, lines 27-29). This is not an insignificant difference. Rather, it is important that a player/trader know with whom they are dealing so that they may assess the risk involved in the transaction. For example, a particular indication may be priced below market price, however, the indication is offered by an unreliable source that may or may not be able to fulfill any contract entered into. By allowing the player/trader to identify with whom they are potentially dealing, the player/trader may make an informed decision with regard to the particular indication. This cannot be done with the system taught in the '501 patent.

It is well settled that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In the present case, Applicant respectfully submits that a primary objective of the '501 patent and even the title of the patent, is an


anonymous matching system for anonymously matching active bids and offers.

Therefore, any modification of the '501 patent according to the Claims 1 and 24 to require player selection and submission would destroy the objective of the system taught in the '501 patent.

Accordingly, because the '501 patent fails to teach or suggest, a database accessible by said computer containing a plurality of indications submitted by and identified with players of the system to said computer over said computer network, wherein each of said plurality of indications identified with a particular player, relates to a bid or offer for a specified number of units of a specified commodity at a specified unit price as required by Claims 1 and 24, but rather teaches directly away from this limitation using an anonymous system, the '501 cannot render Claims 1 or 24 obvious.

It is respectfully submitted that claims 1 – 25, all of the claims remaining in the application, are in order for allowance and early notice to that effect is respectfully requested.

Respectfully submitted,



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